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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.						
09/982,093	10/19/2001	S. Rao Cherukuri	24222-X3	6757						
7590 02/22/2005										
Gary M. Nath NATH & ASSOCIATES PLLC 6th Floor 1030 15th Street, N.W. Washington, DC 20005		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>FUBARA, BLESSING M</td></tr></table> <table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1615</td><td></td></tr></table>			EXAMINER	FUBARA, BLESSING M	ART UNIT	PAPER NUMBER	1615	
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1615										
		DATE MAILED: 02/22/2005								

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,093

Applicant(s)

CHERUKURI, S. RAO

Examiner

Blessing M. Fubara

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 8-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Examiner acknowledges receipt for request for extension of time, request for continued examination under 37 CFR 1.114, amendment and remarks, all filed 01/14/05. Claims 8-24 are withdrawn from consideration.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/14/05 has been entered.

#### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jerussi et al. (US 6,197,828).

Jerussi teaches compositions comprising derivatives of (+) isomer of venlafaxine. The (+) isomer of venlafaxine derivative is combined with pharmaceutical carriers; microcrystalline cellulose, lactose, pre-gelatinized starch, croscarmellose and magnesium stearate are combined with the active agent (claim 7). The dosage form of the composition is tablets, caplets, troches, lozenges, and other forms (column 15, lines 12-53). See also abstract, column 2, lines 29-40 and 55-65, column 3, lines 1-28, column 16, lines 3-15 and claims 1-9).

Jerussi clearly teaches the caplet formulation of the instant claims where the active agent is venlafaxine. Jerussi does not disclose the size of the caplet and thus the difference between Jerussi and the claims is one of size and differences in size would not support the patentability of applicant's caplet over the caplet of the prior art. Also, applicant has no comparable data to show the instant caplet having a diameter of about 1 millimeter to about 7 millimeter and having a length of about 1 millimeter to about 7 millimeter provides unusual results. Generally, differences in sizes will not support the patentability of subject matter encompassed in the prior art unless there is evidence indicating the size is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable" sizes by routine experimentation. In the present case, Jerussi is silent on the size of the caplet. But, caplets by their very nature have length and diameter.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a composition comprising venlafaxine and to formulate the composition as a caplet with the expectation that the caplet composition would be effective to treat depression when administered.

#### ***Response to Arguments***

4. Applicant's arguments filed 01/14/05 have been fully considered but they are not persuasive.

Applicant's argument regarding the size of the caplet is not persuasive because differences in the size of the caplet and differences in size would not support the patentability of applicant's caplet over the caplet of the prior art. Applicant has no comparable data to show that

the caplet of prior art in terms of the size does not meet all the arguments presented or the size of applicant's caplet in relation to any known caplet does not have those attributes listed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Blessing Fubara  
Patent Examiner  
Tech. Center 1600

